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REMARKS

This amendment is to enter claims proposed in the prior amendment under rule 116, plus two new claims relating to the embodiment of Fig. 3 have been added. Applicant respectfully submits that these claims distinguish even more clearly over the references than do the prior claims.

The Examiner previously stated that no fee was enclosed with the IDS. Applicant respectfully disagrees. There was a deposit account authorization.

The arguments below are copied from the amendment under rule 116.

Rejections under section 112

The rejection under section 112 in the final office action should be moot as the claims to which it relate have been cancelled.

The rejections under section 112 from the prior action are respectfully traversed.

Reciting the medium

The requirement that the medium be recited positively is respectfully traversed as without basis in law. The case of Special Equipment v. Coe, 324 US 370 (1945) decided that subassemblies could be claimed. The fact that a holder is adapted to hold a medium does not mean that the medium must be claimed.

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Also since the holder can be distributed separately from the medium that it is designed to hold, it is in fact a useful product in and of itself. Adding a recitation of the medium would limit the Applicant's ability to enforce the patent against the holder. Such a limitation is not justified by the art, as the art shows the prior art holders with their media, so adding the media would not distinguish over them.

Standard size

The Examiner previously argued that credit cards and business cards do not have a standard size.

The undersigned just turned 50 years old. During her life she has handled and otherwise observed a fair number of credit/debit cards. She has always observed credit or debit cards to be exactly the same size. She successfully inserts her credit/debit cards into machines all over the country and they always fit. She has even taken a US ATM card and inserted it successfully in ATM machines in Canada and The Netherlands. She could not have done this if these cards were not a standard size. The undersigned has also seen credit cards being used by tourists from all over the world here in the NY metro area, and all those credit cards are exactly the same size, again because otherwise they could not be used in the machines that are intended to receive them.

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Similarly, the undersigned has observed that business cards in this country are always the same size. She has even seen very fancy metal business card holders -- sold in upscale stores -- that fit standard business cards to within less than a millimeter, and all business cards fit exactly in those same holders. Only a very odd person, such as perhaps a craftsperson trying to demonstrate how very artsy-craftsy he or she was, would have different sized business cards, because different sized business cards would not fit into standard business card holders — and even then everyone handling the non-standard sized business cards distributed by the artsy-craftsy person would immediately understand that those were non-standard cards and therefore a statement of rebellion or creativity.

Also wallets and rolodexes are designed to hold business and/or credit/debit cards.

The undersigned did observe that business cards in Europe were a slightly different size from the US, but even then all business cards in Europe were the same size as each other.

Applicant accordingly respectfully traverses the Examiner's allegation that the term "standard size" in the claims is not definite.

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Art rejections

The art rejections of the original claims, as set forth in the prior office action are respectfully traversed.

Patentability of size

It is to be imagined why the Examiner wonders, "Why is size patentable here? After all, things come in different sizes." The answer is that this particular size, the size of a standard credit card or standard business card, is indeed a standard size. There are already a plethora of wallets and card holders made to carry things of this size. When a medium is placed on a holder as recited in the claim, the medium can be safely placed in one of these ubiquitous convenient devices. This was not possible with prior devices. Indeed, it is not so easy with current devices either. The undersigned recently purchased a small flash drive from Staples and was then at a loss where to store it so that neither the drive nor its cap would get lost or damaged and yet be always conveniently at hand. The undersigned does carry a purse with a number of zippered pockets and pouches into which the drive can be inserted, thus begging the later question of which pouch the undersigned has chosen for the tiny drive, resulting in the potential for searching expeditions and repeatedly dumping out the purse – not to mention possible loss of the protective cap. The undersigned never, however, has this problem with credit/debit

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cards, which are so conveniently organized in her wallet, along with her driver's license and health insurance card – all of which are exactly the same size, so that they fit in the little credit card slots and do not fall out; and, moreover, the undersigned takes especial care never to lose the wallet, precisely because of its special concentration of important identically sized cards. Accordingly, a medium would be ever so much more useful and convenient if it were stored in a credit card sized holder.

The primary reference relates to a holder for standard DVD's. The undersigned has also handled a fair number of standard DVD's. These are also a standard size. Each DVD fits in all DVD players. However, a DVD would not fit on a holder that was the size of a standard credit card or business card. Such a holder would be too small for a DVD. If the Examiner were to take a standard credit card and a standard DVD as shown in the reference and show both to a kindergartener, and ask the latter if the DVD would fit on the credit card, the child would laugh at the Examiner. Accordingly, the holder of the reference cannot be interpreted to teach or suggest the size of a standard credit or business card.

The law regarding size and patentability has somewhat been discussed in the prior response. Applicant would like to supplement that discussion here.

With respect to the Rose case, it should be understood that the case points out that the decision of lack of patentability rests not only on the issue of size, but also on the fact

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that the features considered in that case performed in combination the same function as set forth in the prior art.

Similarly, Gardner v. Tec Systems, 725 F. 2d 1338, 220 USPQ 777 (Fed. Cir. 1984) also cited by 2100 MPEP 2144.04 concluded that size did not confer patentability where "structural differences over the prior art do not necessarily result in differences in performance over the prior art." 725 F. 2d at 1345-6 and "did not produce any discernible result or any synergistic[sic] effect" 725 F. 2d at 1346. The court found that "the dimensional limitations ... failed to particularly point out a feature ... which performed any differently from prior art ... in other words, those limitations are a verbal difference only." The clear implication here is that a dimensional limitation could convey a patentable distinction — if a difference in performance, discernible result, or synergistic effect were produced.

Similarly a recent scholarly article, R. Scott Roe, "Note: Nanotechnology: When Making Something Smaller Is Nonobvious," 12 B.U. J. SCI. & TECH. L. 127 (2006) has argued that size does in fact convey patentability in certain circumstances.

The undersigned has also located Ex parte Luan Tran et al., cited in the prior amendment, a copy of which is available on the PTO website. A copy of that decision is now hopefully attached. It is stated to be a non-precedential decision; however, the topic of whether adjudicatory bodies can actually legally make their decisions non-precedential

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is controversial. Enclosed is a copy of an ABA article from www.nonpublication.com including some case law indicating that courts may not make their decisions non-precedential. According to this website, the Supreme Court decided on April 12, 2006 that by December 1 all federal cases will be citable in federal courts. In any case, the board case does at least illustrate that the board does sometimes allow patents based on size.

In the present invention, the function of being a standard size, a size that is in fact adapted to the ubiquitous standard carrying devices of our culture, is indeed a difference in performance, discernible result, or synergistic effect, as discussed in the case law. This performance, result, and effect are not taught or suggested in the prior art and indeed are not even possible with a DVD as shown in the primary reference.

Reconsideration of the rejection is accordingly respectfully requested.

Claim 14 (formerly 5)

This claim recites: a holder according to claim 13 wherein the planar area of the holder is at least 100% greater than the planar area of the computer readable storage medium. An example of this feature is illustrated in Fig. 3 of the application. This feature has the functional advantage, as illustrated in the figure, that two media can be placed side by side on the holder, as shown in the figure.

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Against the recitations of this claim, the Examiner has stated again that size is not patentable. However, again the functional advantage of this particular size is not taught or suggested by the reference. Accordingly, this limitation does distinguish patentably over the reference.

Any of the Examiner's rejections and/or points of argument that are not addressed above would appear to be moot in view of the following. Nevertheless, Applicant reserves the right to respond to those rejections and arguments and to advance additional arguments at a later date. No arguments are waived and none of the Examiner's statements are conceded.

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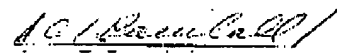
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Applicant respectfully submits that he has addressed each issue raised by the Examiner — except for any that were skipped as moot — and that the application is accordingly in condition for allowance. Allowance is therefore respectfully requested.

Respectfully submitted,

By



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